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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/825,285	04/04/2001	Raymond John Herbert	5006	4054
26936 7590 04/24/2009 SHOEMAKER AND MATTARE, LTD 10 POST OFFICE ROAD - SUITE 100 SILVER SPRING, MD 20910				
EXAMINER				
WORJLOH, JALATIE				
ART UNIT		PAPER NUMBER		
3685				
MAIL DATE		DELIVERY MODE		
04/24/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary****Application No.**

09/825,285

**Applicant(s)**

HERBERT, RAYMOND JOHN

**Examiner**

Jalatee Worjloh

**Art Unit**

3685

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 January 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 3-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 3-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Response to Amendment***

1. This Office Action is responsive to the amendment filed January 26, 2009.
2. Claims 3-9 are pending.

***Response to Arguments***

3. Applicant's arguments filed January 26, 2009 have been fully considered but they are not persuasive.
4. In response to applicant's argument that there is no suggestion to combine the references, the Examiner notes that KSR forecloses the argument that a specific teaching, suggestion, or motivation is required to support a finding of obviousness. See *KSR*, 127 S. Ct. at 1741, 82 USPQ2d at 1396.
5. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 3-6 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 5683190 to Gawler in view of US Patent No. 7069247 to Oppedahl.

Referring to claim 3, Gawler discloses feeding a mail piece along a feed bed (see abstract, fig. 1, and col. 2, lines 34-38), utilizing a sensor to scan a band on the fed mail piece to detect a sequence and generating an indication of a presence of the imprint of the postal indicium in response to detection (see col. 3, lines 65-56 and col. 4, lines 1-5 – a sensor senses when the leading edge of the mail item passes a predetermined location along the feed bed and outputs a control signal). Gawler does not expressly disclose detecting a sequence of transitions between areas of light and dark reflectance with the band, the band extending across the location and generating an indication in response to detection of a transition succeeding a predetermined number of initial transitions at a start of the sequence transaction. Oppedahl discloses detecting transitions between areas of light and dark reflectance with a band (see col. 3, lines 48-51). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify Gawler to detect the elements of Oppedahl. One of ordinary skill in the art would have been motivated to do this because it provides a method for effectively verifying mail pieces (see Oppedahl, col. 2, lines 30-32 ).

Referring to claims 4 and 5, Gawler discloses postal indicium (see claim 3 above). Gawler does not expressly disclose the postal indicium includes an area in which postal data is printed in machine readable, two dimensional or data matrix form. Oppedahl the postal indicium includes an area in which postal data is printed in machine readable, two dimensional or data matrix form and cryptographic data (see abstract). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the postal indicium of Gawler to include an area in which postal data is printed in machine readable, two dimensional or data matrix form and cryptographic data. One of ordinary skill in the art would have been motivated

to do this it provides a method for effectively verifying mail pieces (see Oppedahl, col. 2, lines 30-32 ).

Claims 6 and 8 are rejected on the same rationale as claim 3 above.

8. Claims 7 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gawler and Oppedahl as applied to claims 6 and 9 above, and further in view of US Patent No. 5907833 to Lee.

Referring to claim 7, Gawler in combination with Oppedahl disclose the features of claim 6. Gawler does not expressly disclose stopping the feeding of further mail pieces past the print head in the event that no postal indicium is detected on the fed mail piece. Lee discloses stopping the feeding of further mail pieces past the print head in the event that no postal indicium is detected on the fed mail piece (see fig. 3, block 55 & related text). At the time the invention was made it would have been obvious to a person of ordinary skill in the art to modify Gawler to stop feeding mail pieces past the print head in the event that no postal indicium is detected on the fed mail piece. One of ordinary skill in the art would have been motivated to do this because it reduces mail piece feeding errors.

Referring to claim 9, Gawler in combination with Oppedahl and Lee discloses the features of claim 9 (see claim 8 above & Lee, Fig. 5, and associated text).

### ***Conclusion***

Applicant is reminded that functional recitation(s) using the word “for” or other functional language (e.g. “operable to”), as recited in claim 8, have been considered but are given little patentable weight<sup>1</sup> because they fail to add any structural limitations and are thereby regarded as

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<sup>1</sup> See e.g. *In re Gulack*, 703 F.2d 1381, 217 USPQ 401, 404 (Fed. Cir. 1983)(stating that

intended use language. A recitation of the intended use of the claimed product must result in a structural difference between the claimed product and the prior art in order to patentably distinguish the claimed product from the prior art. If the prior art structure is capable of performing the intended use, then it reads on the claimed limitation. *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) (“The manner or method in which such machine is to be utilized is not germane to the issue of patentability of the machine itself.”); *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). See also MPEP §§ 2114 and 2115. Unless expressly noted otherwise by the Examiner, the claim interpretation principles in this paragraph apply to all examined claims currently pending.

### ***Conclusion***

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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although all limitations must be considered, not all limitations are entitled to patentable weight).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jalatee Worjloh whose telephone number is 571-272-6714. The examiner can normally be reached on Monday - Friday 10:00 - 6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Calvin Hewitt II can be reached on 571-272-6709. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300 for regular communications and 571-273-6714 for Non-Official /Draft.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jalatee Worjloh/  
Primary Examiner, Art Unit 3685